

REMARKS

Initially, Applicants would like to thank the Examiner for indicating the acceptability of the drawings filed with the present application on February 10, 2004. Applicants would also like to thank the Examiner for acknowledging receipt of the PTO-1449 form that was submitted with Applicants' Information Disclosure Statement on May 11, 2005, as well as for acknowledging consideration of each of the references listed on the above-noted PTO-1449 form.

However, Applicants note that the Examiner did not acknowledge Applicants' claim for foreign priority under 35 U.S.C. §119, nor receipt of copies of the certified copies of all of the priority documents (i.e., Japanese Application No. 2003-138099 and Japanese Application No. 2003-031817) upon which Applicants' claim for foreign priority under 35 U.S.C. §119 is based. In this regard, Applicants submitted a Claim of Priority and a copy of a certified copy of Japanese Application No. 2003-031817 with the present application on February 10, 2004. Additionally, Applicants submitted a copy of a certified copy of Japanese Application No. 2003-138099 on July 2, 2004. Accordingly, with the next Official Action, Applicants request that the Examiner acknowledge Applicants' claim for foreign priority under 35 U.S.C. §119, as well as receipt of copies of the certified copies of all of the priority documents (i.e., Japanese Application No. 2003-138099) upon which Applicants' claim for foreign priority under 35 U.S.C. §119 is based.

In the outstanding Official Action, claims 1-3 and 20 were rejected under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2004/0122290 to ORION et al. Claims 1-3 and 20 were also rejected under 35 U.S.C. §102(b) over U.S. Patent

No. 5,989,185 to MIYAZAKI. Claims 4-12, 14 and 19 were rejected under 35 U.S.C. §103(a) over MIYAZAKI in view of U.S. Patent No. 5,193,525 to SILVERSTEIN. Claim 13 was rejected under 35 U.S.C. §103(a) over MIYAZAKI in view of SILVERSTEIN, and further in view of U.S. Patent No. 4,790,295 to TASHIRO. Claim 15 was rejected under 35 U.S.C. §103(a) over MIYAZAKI in view of SILVERSTEIN, and further in view of U.S. Patent No. 4,593,682 to HECKELE. Claims 16-18 were rejected under 35 U.S.C. §103(a) over MIYAZAKI in view of SILVERSTEIN, and further in view of U.S. Patent No. 6,530,882 to FARKAS et al.

In view of the herein-contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of each of the above-noted rejections. In this regard, upon entry of the present amendments, Applicants will have cancelled claims 1, 19 and 20 without prejudice to or disclaimer of the subject matter recited therein. Additionally, Applicants will have amended claims 2 and 4 into independent form to include substantially all of the features previously recited in claim 1. Claim 16 will have been amended to depend from claim 2. Claims 3 and 17 will have been amended to eliminate informalities. Further, claims 21-23 will have been added for consideration by the Examiner. In this regard, claims 21-23 recite subject matter similar to the features recited in claims 16-18, but claims 21-23 depend from independent claim 4 whereas claims 16-18 depend from independent claim 2.

Applicants traverse each of the outstanding rejections. In this regard, Applicants respectfully submit that each of independent claims 2 and 4 is allowable over each of the references applied in the outstanding Official Action, whether the references are considered alone or in any proper combination.

With respect to the rejection of claim 2 over IRION, the outstanding Official Action asserts that IRION discloses “an endoscope wherein a portion of the second optical system is within the field of view 134 of the first optical system (see Fig. 4)”. Applicants submit that this assertion is in error. In this regard, the outstanding Official Action is interpreting the claimed “first optical system” as element 106 in IRION, and the claimed “second optical system” as element 108 in IRION. However, as can be seen in Figure 4 in IRION, element 108 is not itself within the field of view of element 106. Rather, the fields of view of elements 106 and 108 overlap, but neither element is itself within the field of view of the other. In contrast, as can be seen in the exemplary embodiments shown in Figures 3 and 4 of the present application, a confocal unit 85 and a cover portion 89a of the tip body are arranged such that they are partially located within the image displayed on a first monitor 310, or within the view field of the first optical system 81 (see, e.g., paragraph [0058] of the present application).

Further, it appears that it would not be possible to modify IRION to obtain the invention recited in claim 2 without destroying the teachings of IRION. In this regard, if element 106 in IRION were moved back, than the field of view of element 106 (i.e., image field 110) would be constricted to a field that is smaller than the field 110 which is shown in Figure 4 of IRION. Accordingly, IRION does not disclose or suggest, in the claimed combination, “a portion of said second optical system is within the field of view of said first optical system”, as recited in claim 2.

Additionally, the outstanding Official Action asserts that IRION discloses, at paragraph [0070], that a magnification of element 108 is higher than a magnification of element 106. However, IRION discloses at paragraph [0068] that “[t]he first imaging

system 106 and the second imaging system 108 differ... from one another with regard to at least one optical parameter, specifically in the present case with regard to their aperture angle 130 and 132" (emphasis added). Accordingly, IRION does not disclose or suggest the claimed combination of "a first optical system... for observing... at a first magnification... and a second optical system... for observing... at a second magnification", as recited in claim 2.

Furthermore, Applicants note that the invention recited in claim 2 can be used to obtain benefits not possible in IRION. For example, using the invention recited in claim 2, a relational perspective can be provided because a portion of the second optical system is within the field of view of the first optical system. Accordingly, it is possible to easily observe a desired location with higher magnification in a useful perspective.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. §102(e) over IRION.

With respect to the rejection of claim 2 over MIYAZAKI, the outstanding Official Action asserts that MIYAZAKI discloses "an endoscope wherein a portion of the second optical system is within the field of view 134 of the first optical system (see Col. 5, Lines 1-10)". Applicants submit that this assertion is in error. Initially, Applicants note that the field of view 134 is a teaching of IRION and not MIYAZAKI.

With respect to the teachings of MIYAZAKI, the outstanding Official Action is interpreting the claimed "first optical system" as element 36 in MIYAZAKI and the claimed "second optical system" as element 37 in MIYAZAKI. However, as can be seen in Figures 4 and 5, element 36 is not itself within the field of view of element 37 in MIYAZAKI. Rather, the fields of view of elements 37 and 37 overlap, but neither

element is itself within the field of view of the other. Accordingly, with respect to this feature recited in amended claim 2, MIYAZAKI discloses no more than IRION.

Further, it appears that it would not be possible to modify MIYAZAKI to obtain the invention recited in claim 2 without destroying the teachings of MIYAZAKI. In this regard, if element 36 in MIYAZAKI were moved back, than its image field would be constricted to a field that is not suitable as a "telephotographic" field (see col. 5, lines 4-12) described therein. Accordingly, MIYAZAKI does not disclose or suggest, in the claimed combination, "a portion of said second optical system is within the field of view of said first optical system", as recited in claim 2.

The invention recited in claim 2 can also be used to obtain benefits not possible using the invention of MIYAZAKI. For example, using the invention recited in claim 2, a relational perspective can be provided because a portion of the second optical system is within the field of view of the first optical system. Accordingly, it is possible to easily observe a desired location with higher magnification in a useful perspective.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. §102(b) over MIYAZAKI.

With respect to the rejection of claim 4 over MIYAZAKI in view of SILVERSTEIN, the outstanding Official Action admits that "Miyazaki... is silent with respect to wherein the first optical system and the second optical system are provided on an end surface of the tip body, the second optical system being arranged such that at least a front end portion thereof is protruded with respect to the first optical system", but asserts that "Silverstein et al. teach of an analogous endoscope having a tip 70 that includes an opaque recess 108 positioned to mate with projection 110 surrounding the image viewer

54 and extending from the top surface of the endoscope 50 (see Col. 9 Lines 37-68 and Fig. 11)". The outstanding Official Action also asserts that "[i]t would have been obvious to one skilled in the art... to arrange the second optical system in the apparatus of Miyazaki to be protruded with respect to the first optical system in order to trap all light, such that no light is able to successfully reflect internally within the lens material within the endoscope as taught by Silverstein et al.".

Applicants submit that the above-noted assertions are in error. In this regard, the projection 110 in SILVERSTEIN is used to "prevent light from spreading from the light guide 52 to the image viewer 54". Accordingly, while SILVERSTEIN teaches projecting a system with an image viewer with respect to a light guide 52, SILVERSTEIN does not teach protruding a front end portion of a "second optical system" used "for observing... at a second magnification" with respect to a "first optical system" used "for observing... at a first magnification": Further, the outstanding Official Action admits that MIYAZAKI does not disclose or suggest this feature.

In other words, the projection 110 in SILVERSTEIN is provided to ensure that light does not directly enter the tip from the light source end to cause glare (see column 10, lines 1-12). In contrast, the front end portion of the second optical system (for observing at a second magnification) is protruded with respect to the first optical system (for observing at a first magnification). Among the benefits of the invention recited in claim 4, the second optical system can be used to contact a target without the first optical system contacting the target. This helps to ensure that a first optical system is not deflected (i.e., inclined), even when the second optical system contacts a target.

This benefit of the invention recited in claim 4 is described in the present application at paragraphs 60 and 61.

Accordingly, Applicants respectfully submit that there is no proper motivation to modify the teachings of MIYAZAKI with the teachings of SILVERSTEIN; rather, the only motivation to modify the teachings of MIYAZAKI with the teachings of SILVERSTEIN is the improper motivation of the Examiner to obtain Applicants' claimed invention in hindsight.

Applicants further submit that, as explained above, even the combination of MIYAZAKI with SILVERSTEIN would not obtain the invention recited in Applicants' claim 4. In this regard, neither MIYAZAKI or SILVERSTEIN discloses any motivation to protrude a second optical system (for observing... at a second magnification) with respect to a first optical system (for observing... at a first magnification). Rather, if anything, MIYAZAKI modified with the teachings of SILVERSTEIN would project both optical systems 36 and 37 with respect to any light source.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claim 4 over MIYAZAKI in view of SILVERSTEIN.

Accordingly, at least for each and all of the reasons set forth above, Applicants respectfully submit that each of independent claims 2 and 4 is allowable over the references applied in the outstanding Official Action. Applicants further submit that each of claims 3, 5-18 and 21-23 is allowable at least for depending, directly or indirectly, from an allowable independent claim 2 or 4, as well as for additional reasons related to their own recitations.

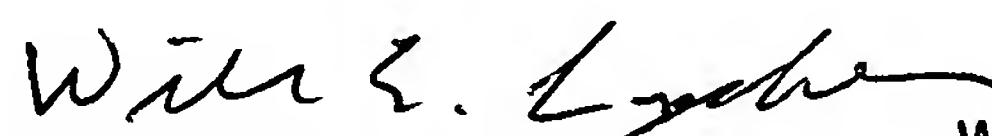
SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application into condition for allowance, and believe that they have now done so. Applicants have discussed the disclosure of the references relied upon in the outstanding Official Action and have pointed out specific features of the claims not disclosed by the references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims pending in the present application and respectfully request an indication to such effect, in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Shinsuke OKADA et al.



Bruce H. Bernstein
Reg. No. 29,027

William E. Lyddane
Reg. No. 41,568

July 18, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191